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EXAMINER

GUPTA, ANISH

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 07/01/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,098

Applicant(s)

SAKAGAMI ET AL.

Examiner

Anish Gupta

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: _____

DETAILED ACTION

1. The Preliminary amendments, filed 1-22-02, have been entered in the application. Claims 1-17 were canceled by the amendment and claims 18-19 were added. Claims 18-19 are pending in this application.

Specification

2. The use of the trademark such as DEAE Sephadex A-25, DEAE cellulose, DEAE Sepharose, Bio-Gel P2, Bio Gel P4, Diaion HP-20, and Pronase E has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 contains the trademark/trade name Cosmosil 75C₁₈-OPN, Diaion HP-20, Pronase E, and Deae Sephadex A-25. Where a trademark or trade name is used in a claim as a limitation to

identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe chromatographic resins and enzymes and, accordingly, the identification/description is indefinite.

Claim 19 is indefinite because a concise definition of "hardly soluble", in step (a), cannot be ascertained. Hardly soluble implies that there is a degree of solubility. However, the claim does not state the degree of solubility for the growth factor in ethanol and acetone and thus one would not know what "hardly soluble in ethanol and acetone" would be defined as. Further, it is unclear if the "hardly soluble" degree is the same for both ethanol and acetone or if the solubility in one solvent is greater than the other.

Written Description

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. The courts have stated:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that 'the inventor invented the claimed invention.'" Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966." Regents of the University of California v. Eli Lilly & Co., 43 USPQ2d 1398.

The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include "level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient." MPEP 2163.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In Regents of the University of California v. Eli Lilly & Co., the court stated:

"A written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials. Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606; In re Smythe, 480 F.2d 1376, 1383, 178 USPQ 279, 284-85 (CCPA 1973) ("In other cases, particularly but not necessarily,

chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus. . . ."). Regents of the University of California v. Eli Lilly & Co., 43 USPQ2d 1398.

The MPEP further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP 2163. The MPEP does state that for generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. MPEP 2163. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP 2163. Although the MPEP does not define what constitute a sufficient number of representative, the Courts have indicated what do not constitute a representative number species to adequately describe a broad generic. In Gostelli, the Court determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. In re Gostelli, 872 F.2d at 1012, 10 USPQ2d at 1618.

In the instant case, the claims are drawn to a growth factor peptide obtained from liliaceous plants by incubating the collected cells from the plant in a plant cell cultivation medium. This generic statement growth factor peptide fails to adequately describe a structural feature common to the genus since the only common feature would be an amide bond between the amino acids. Further, the polypeptide and proteins of the claims are not limited to any specific class of compounds for which one could readily obtain physical and/or chemical properties or functional characteristics thereby obtaining some insight as to the structure of the desired proteins or polypeptide. The specification provides some examples of growth factor peptides. However,

these peptides are limited to small four or five amino acid peptides that have a tyrosine residue in the first and third positions. Beyond these small peptides, the specification does not provide any written description of other peptides that would qualify as a growth factor peptide. The specification, as a whole, does not sufficiently provide ample definition, such as by structure, formula, or chemical name, of the claimed subject matter sufficient to distinguish it from other peptides. Accordingly, the disclosure lacks sufficient written description to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

As stated earlier, the MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable claim 1 is a broad generic with numerous variants. A growth factor peptide obtained from a liliaceous plants via plant cell cultivation medium is inclusive of numerous peptides. The Liliaceous plant genus is broad and is inclusive of distinct plants such as, onion, garlic, asparagus, tulips, hyacinths, day lily, and aloe. This further increases the number of possible peptides that can be isolated and designated as growth factors. The limitations of the process to isolate the growth factor peptide does not substantially limit the number of species or variation of species encompassed by claims since the claim is a product claim and is not limited by the process of making or manufacture. Similarly, the physio-chemical properties recited in claim 19 do not give any insight into the structure. Properties such as the peptide is acidic and polar, only implies that there is higher number of acidic and polar amino acid, such as aspartic acid, glutamic acid, tyrosine, cystine, asparagine, glutamine, serine, and threonine, present. However, the number of these amino acids can vary since the claim does not recite an amino acid length for the growth factor. It must not be

forgotten that the MPEP states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP 2163. Here, though the claims may recite a method of obtaining the peptide and some characteristics, the claims lack written description because there is no disclosure of a correlation between function and structure of the sequence. Moreover, the specification lack sufficient variety of species to reflect this variance in the genus since the specification only provides examples of tetra and penta-peptides. Further, these peptides are further limited in that they contain a tyrosine residue in the first and third positions. The specification is void of any peptides that contain structurally distinct acidic amino acids as aspartic acid or glutamic acid as those amino acids contributing to the acidic nature of the peptide. Further, the specification is void of any peptides that have an amino acid length longer than four or five amino acids. Thus, the small genus exemplified does not provide ample written description to any growth factor peptide, regardless of amino acid length, obtained from any liliaceous plant. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See In re Wilder, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, the examples provided in the specification cannot constitute written description to any growth factor as encompassed by the claims. Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

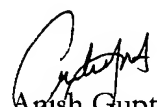
7. Claims 18-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,004,906. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The claims are drawn to a plant growth factor peptide obtained from liliaceous plants.

The US Patent claims tetra and penta-peptides that have a tyrosine residue in positions one and three of the sequence (see claim 1). The Patents's claimed peptides are plant growth promoters and are isolated from asparagus (see claim 2 and claim 12). Note that asparagus is disclosed to be a preferred liliaceous plant in the instant application (see page 5 of the specification). Further note that the peptides of claim 1 in the US patent is the same peptides disclosed in the instant specification as a "plant growth factor" and have the same generic formula (See page 4 of the specification). Since the peptides of the US Patent are the same as the peptide of the instant application and are growth factor, the physio-chemical properties listed in claim 19, of the instant application would be identical for both growth factor peptides claimed. Thus, the US patent claims and the instant application claims are mutually inclusive of the same subject matter and are not patentably distinct from each other.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback , can normally be reached on (703)306-3220. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Anish Gupta
Patent Examiner

6/27/03